285

IN THE

# [redacted] COURT OF APPEALS

FOR THE THIRD CIRCUIT

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No. 4,[redacted]. [redacted] TERM, 1933.

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CHARLES B. GRAY,

Appellant,

v.

EASTMAN KODAK COMPANY, EASTMAN KODAK COMPANY OF NEW YORK, and EASTMAN KODAK STORES, INC.,

Appellees.

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## PETITION FOR REHEARING.

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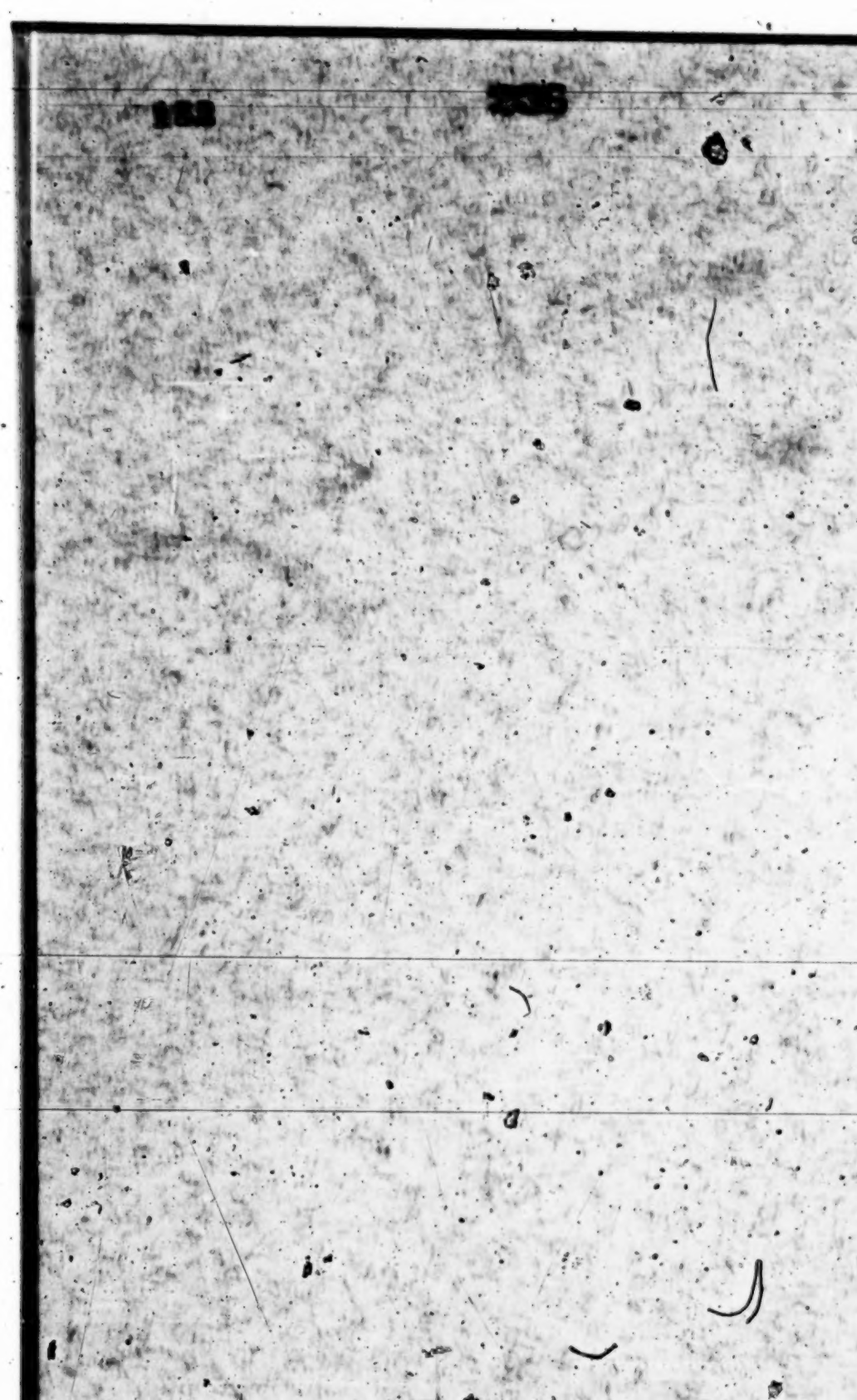

# In the United States Circuit Court of Appeals for the Third Circuit.

No. 4986. October Term

*Charles B. Gray, Appellant,*

v.

*Eastman Kodak Company, Eastman Kodak Company of New York, and Eastman Kodak Stores, Inc., Appellees.*

## PETITION FOR REHEARING.

On behalf of appellees, we respectfully petition for rehearing.

The petition is based on the following points:

1. The opinion does not adequately state the reasons moving this Court to overrule appellees' challenge to its jurisdiction to review the conclusions of the trial Judge upon which he adjudged claims 1, 2, 5 and 6 of Gray's patent invalid and claim 3 not infringed.

2. The provisions of Section 649 and 700 of the Revised Statutes (28 U. S. Code Secs. 773, 875) apply to this case and govern the scope of review by this Court.

3. The question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention is a question of fact even where there is no dispute as to what the improvement was or what was in the prior art. In reaching a contrary conclusion this Court has apparently overlooked the decision of the Supreme Court in *Thompson Spot Welder Co.* v. *Ford Motor Co.*, 265 U. S. 445, 446. The decisions cited in support of the position taken by this Court are inapposite.

4. The decision of this Court that it has power to review the findings of the trial Court is in direct conflict with the decisions of other Circuit Courts of Appeals holding that the question of law whether or not there was any substantial evidence to sustain the findings of the trial Judge is, by force of Sections 649 and 700 of the Revised Statutes (28 U. S. Code Secs. 773, 875), reviewable only when a request or motion is made, denied, and excepted to, or some other like action is taken which presents that question to the trial Court and secures its ruling thereon during the trial.

5. If this Court holds that power to review the findings of the trial Court results from the provisions of Section 269 of the Judicial Code (28 U. S. Code Sec. 391) its decision is in direct conflict with the decision of the Court of Appeals for the Eighth Circuit in *Allen* v. *Cartan & Jeffrey Co.*, 7 F. (2d) 21.

6. This Court has failed to understand appellees' contention that Gray's acquiescence in the rejection of claim 17, during the prosecution of his application, precludes a construction of the word "means" in claims 1 and 2 of his patent which would make them identical with the rejected claim; or, if it has understood the contention, has failed to state adequately the grounds upon which it holds the contrary.

7. This Court failed to distinguish between invention and the attainment of an improved result in holding that

Christie's testimony answered the contention that Gray's device was a mere aggregation of old elements.

8. The presumption of invention that ordinarily flows from the issuance of a patent cannot have application here for the reason that the patent office expressly held that the use of a coiled wire tube for the intervening means is not patentable.

9. It is not true, as stated at p. 10 of the opinion, that "the contention of lack of invention was evidently an afterthought, for at the first trial, no such contention was made."

10. It is not true, as stated at p. 10 of the opinion, that the trial Judge "made no finding of fact" on the question whether the conjoint use of a close wound inner coil and open wound exterior coil involved invention.

**1. The opinion does not adequately state the reasons moving this Court to overrule appellees' challenge to its jurisdiction to review the conclusions of the trial Judge upon which he adjudged claims 1, 2, 5, and 6 of Gray's patent invalid and claim 3 not infringed.**

Counsel for appellees directly challenged the jurisdiction of this Court to review the District Court's decision holding claims 1, 2, 5, and 6 of Gray's patent invalid, and claim 3 not infringed.

It was contended (1) that the cause before this Court is an action at law tried and determined, by stipulation of the parties, without a jury, and governed, therefore, by the provisions of Sections 649 and 700 of the Revised Statutes (28 U. S. Code Secs. 773, 875) which so limit the scope of review in actions to which they apply as to render the de-

cision of the trial Court conclusive on all matters of fact and to prevent any inquiries into the conclusions of law embodied therein, except in so far as the rulings during the progress of the trial were excepted to and duly preserved by bill of exceptions; (2) that by force of Sections 649 and 700 of the Revised Statutes the conclusions of the trial Court* are reviewable only on the ground that they are not supported by any substantial evidence; (3) that whether or not there was any substantial evidence to sustain the conclusions of the trial Court is a question of law reviewable, under the provisions of Sections 649 and 700 of the Revised Statutes, only when a request or motion was made which presented that question to the trial Court and secured its ruling thereon during the trial; (4) that even though such a ruling is secured during the progress of the trial there can be no review of the question unless the ruling was excepted to at the time and duly preserved by bill of exceptions; (5) that the question whether there was any substantial evidence to support the conclusions of the trial Judge was not raised by plaintiff in this case during the progress of the trial either by a request for special findings, by motion for judgment, or otherwise; (6) that appellant's bill of exception fails to disclose the reservation of any exceptions to "the rulings of the Court in the progress of the trial."

In answer to these contentions counsel for appellant filed

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*These conclusions are set forth in the opinion of the District Court (R. 205) as follows:

"1. The combination of closed coil inner thrust member and open coil outer sheath member is not patentable because its elements were known to the prior art and no new mode of operation or functional relationship arises from putting them together."

"2. Claims 1 and 2 cannot be interpreted as calling for a closed coil inner thrust member in view of the file wrapper history of the patent."

"3. Claims 1 and 2 are anticipated."

"4. Claim 3 is not infringed."

"5. Claims 5 and 6 are invalid because United States patent No. 1,297,327, to Dakin and Underwood antedating the plaintiff's application discloses the method of attaching the thrust member to the stem claimed, and conclusion '1' applies to these claims."

a brief in which it was made clear that the only question intended to be raised by appellant's assignment of errors was whether or not there was any evidence in the record to support the findings of the trial Judge.* They did not deny that the case is governed, so far as the scope of review is concerned, by Sections 649 and 700 of the Revised Statutes; nor did they deny that in cases governed by those statutes the findings of the trial Court are reviewable only on the ground that they are not supported by any substantial evidence. They denied appellant's failure to raise this question during the progress of the trial; and denied that the bill of exceptions failed to disclose an exception to such a ruling taken at the time. And, finally, the proposition was advanced that an appellate court, by virtue of Section 269 of the Judicial Code (28 U. S. Code Sec. 391), has power, even in cases governed by Sections 649 and 700 of the Revised Statutes, to review the question of law whether the judgment of the trial Court is sustained by any substantial evidence, even though that question was not raised in the trial Court or excepted to during the trial and preserved by bill of exceptions.

The opinion filed by this Court merely states, in substance, that the evidence in this case supports only an affirmative answer to the question whether what Gray did required the exercise of the faculty of invention, and that this being so, the fact that a jury was waived does not prevent an appellate

*On page 7, paragraph 2, of appellant's answer on brief opposing appellees' motion to dismiss the appeal, counsel for appellant say:

> "It should be noted that the appellant in this case is not asking this Court to review the evidence on any point whatever. He is merely asking the Court to find that the conclusions by which the court below, from evidence and documents which are undisputed, were erroneous. In other words, these conclusions are not supported by any evidence or anything in the record."

Again, on page 8, paragraph 3, second sentence, counsel for appellant say:

> "The special findings made by the court below are erroneous, as appellant claims, because not sustained by anything in the record."

188

court from reviewing the finding of the trial Court that what Gray did involved no invention.*

There can be no doubt but that this is a decision holding this Court has power to pass upon the question whether there is any substantial evidence to support the finding of the trial Court on the question of invention. But the opinion of the Court does not state whether this conclusion is based upon the view that Sections 649 and 700 of the Revised Statutes have no application to this case, or upon the view that those statutes do not impose as a prerequisite for review of the question of law whether the findings of the trial Court are sustained by any substantial evidence that the specific question shall have been presented and ruled upon during the trial and the ruling excepted to at the time and presented by a bill of exceptions, or whether the conclusion of the Court is based upon a finding of fact that appellant did present the question to the trial Court and secure a ruling thereon during the progress of the trial and did except to the ruling at the time and preserve the exception by the bill of exceptions. So far as appears from the opinion, these points, particularly relied upon by appellees, were not considered by this Court. All mention of Sections 649 and 700 of the Revised Statutes is omitted. There is no mention of any one of the many decisions cited in our briefs in support of the contention that where those statutes apply the question of law whether or not there is any evidence to sustain the findings of the trial court is reviewable only when properly raised during the trial and a ruling thereon obtained which is excepted to and preserved by bill of exceptions. The opinion does mention (Opinion p. 2)

* The exact language of the opinion is as follows (Opinion, p. 19):

"Had the present case been tried with a jury, it is clear that with no issue of the fact involved, with the presumption of validity created by the grant of the patent, with the affirmative testimony of defendant's witness Christie showing gained flexibility, with no contradictory testimony whatever, it would have been the duty of the court to instruct the jury the patent was valid and infringed. That jury trial was waived in no way changed this question of law into one of fact or prevents this Court from reviewing the action of the trial Judge in holding this patent invalid."

bill of exceptions "to the rulings, opin- of the trial court, but there is no discus- point made by appellees that the bill of excep- discuss the reservation by appellant of any during the progress of the trial to any

nothing more need be said to per- of the propriety of supplementing the the end that the reasons which to its conclusion may be fully understood. to the parties, to the public, to this Court, which may be asked to review the decision, by an opinion that fully states which led the Court to make it is, of course, importance of such an opinion is where, as here, the question in issue is the committed by Congress to Circuit Courts challenge to the jurisdiction of a court power is fully and persuasively shown.

**The provisions of Sections 649 and 700 of the Revised Statutes (28 U. S. Code Secs. 773, 875) apply in this case and govern the scope of review by this Court.**

The opinion to mention Sections 649 and Statutes or any of the many cases inter- preting them, cited in our briefs," suggests that this Court affirming its power to review the trial Court is founded upon the view that apply it and govern the scope of review. This view is clearly untenable.

by their express terms, are issue of fact in any civil cause in a tried and determined by the Court without whenever the parties, or their

United States, 272 U. S. 658, 673.

attorneys of record, agree to waive a jury by a stipulation in writing filed with the clerk."

In the instant case, by plea of the general issue and notice of special matters of defense (R. 21, 22, 24, 26, 27) defendants raised a number of "issues of fact," among them the issue of invention, the issue of anticipation, and the issue of infringement. The parties, by their attorneys of record, stipulated in writing that the issues so raised be tried to the Court without a jury upon the testimony taken at the jury trial (R. 197), and those issues were tried and determined by the trial Court (Opinion, sur pleadings and proof, R. 198, 205).

It is stated in the opinion of this Court (p. 2) that,

> "In substance, the trial was a quasi demurrer. No witnesses were examined. On final hearing neither party asked for any special findings of fact, for there were no disputed facts."

These statements are inaccurate.

The cause was submitted to the Court below for trial and determination of the issues raised by the pleadings upon the record already made in the first trial, according to the stipulation (R. 197):

> "as if the testimony and exhibits offered in evidence at the trial before Judge Dickinson and a jury had been duly offered in evidence before the Judge who may be assigned to hear this case, subject to any objections which appear on the record, and that all motions made by either party at the said trial shall be deemed to have been made before the Judge trying the case. * * *"

It would be difficult, if not impossible, to find words more apt to express the intention of the parties to have the issues raised by the pleadings tried and determined exactly as in other cases save for the substitution of the Court for the jury as the fact finding tribunal. No *additional* witnesses were examined, it is true, but the trial Court had before

it the testimony of all the witnesses who testified upon the first trial.

The idea that "there were no disputed facts" to be determined by the trial Court is reiterated throughout the opinion. But whatever support there may be for that idea if limited to various specific collateral facts, such as the state of the prior art, the inventions and devices described in prior patents, the nature of defendants' accused devices, etc., there is no warrant whatever in the record for holding that the ultimate facts which go to make up plaintiff's cause of action and defendants' grounds of defense—invention, anticipation, and infringement,—were not in dispute. These ultimate "issues of fact" were never conceded by defendants, and they remained for trial and determination by the trial Judge, who so understood (See opening paragraph of opinion of Judge Kirkpatrick, R. 198). This Court has evidently confused these ultimate "issues of fact" which arose on the pleadings, with "questions" of fact which may be determined either as a matter of fact or a matter of law, depending upon the sufficiency of the evidence to support more than one conclusion respecting the ultimate "issues of fact."

**3. The question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention is a question of fact even where there is no dispute as to what the improvement was or what was in the prior art. In reaching a contrary conclusion this Court has apparently overlooked the decision of the Supreme Court in Thompson Spot Welder Co. v. Ford Motor Co., 265 U. S. 445, 446. The decisions cited in support of the position taken by this Court are inapposite.**

The decision of this Court that it has power to review the decision of the trial Judge on the question of invention is based, in part at least, upon the view that the question whether an improvement over the prior art requires mere

192

mechanical skill or the exercise of the faculty of invention is a matter of law where there is no dispute as to what the improvement was or what was in the prior art.

In reaching this conclusion the decision of the Supreme Court in *Thompson Spot Welder Co.* v. *Ford Motor Co.*, 265 U. S. 445, 446 has apparently been overlooked. There is no mention of it in the opinion. In that case the Supreme Court said (p. 446):

> "The question whether an improvement requires mere mechanical skill or the exercise of the faculty of invention, *is one of fact*, and in an action at law for infringement is to be left to the determination of the jury. *Keyes* v. *Grant*, 118 U. S. 25, 36, 37; *Holmes* v. *Truman* (C. C. A.) 67 Fed. 542, 543; *Hall* v. *Wiles* (C. C.), 2 Blatchf. 194, 11 Fed. Cas. 280, 283; *Poppenhausen* v. *Falke* (C. C.), 5 Blatchf. 46, 19 Fed. Cas. 1052, 1054; *Shuter* v. *Davis* (C. C.), 16 Fed. 564, 568; *Blessing* v. *Copper Works* (C. C.), 34 Fed. 753, 754."

In support of the view taken by this Court the opinion cites the decisions of the Supreme Court in *Heald* v. *Rice*, 104 U. S. 749, *Market Street R. Co.* v. *Keasley*, 155 U. S. 625, and *Singer* v. *Cramer*, 192 U. S. 275. These cases, however, do not support the proposition to which they are cited. They merely hold that the question of *identity* may be a matter of law. Thus, in *Heald* v. *Rice* the validity of a reissued patent was challenged on the ground that the reissue patent was not for the same invention as the original patent. In *Market Street R. Co.* v. *Keasley*, the validity of the patent in suit was challenged on the ground that the inventions and devices described in prior patent disclosed the same invention as the patentee claimed. In *Singer* v. *Cramer*, the question was whether the Diehl device, upon which the charge of infringement was based, was substantially the same as that of Cramer. Where the question is whether an improvement over the prior art involved the exercise of invention, novelty over the prior art is conceded, and the question of identity is not an issue.

**4. The decision of this Court that it has power to review the findings of the trial Court is in direct conflict with the decisions of other Circuit Courts of Appeal holding that the question of law whether or not there was any substantial evidence to sustain the findings of the trial Judge, is, by force of Sections 649 and 700 of the Revised Statutes (28 U. S. Code Secs. 773, 875), reviewable only when a request or motion is made, denied, and excepted to, or some other like action is taken which presents that question to the trial Court and secures its ruling thereon during the trial.**

It is the essence of the decision of this Court holding that it has power to review the findings of the trial Court that "Had the present case been tried with a jury, * * * it would have been the duty of the court to instruct the jury the patent was valid and infringed," because there was no substantial evidence to sustain any other conclusion (Opinion p. 19).

That this is a question of law which arises in the progress of the trial and is reviewable *only* when a ruling on that specific question is evoked during the progress of the trial either by motion for judgment at the close of the testimony or by a request made for a declaration of law, excepted to at the time, and duly preserved by a bill of exceptions, has been held by the Courts of Appeals for the First, Fourth, Sixth, Eighth and Ninth Circuits, as well as by the Supreme Court.

The Court of Appeals for the First Circuit so held in *Arthur C. Harvey Co. v. Maley*, 60 Fed. (2d) 97, affirmed by the Supreme Court March 13, 1933 (1 U. S. Law Week Adv. Op. Vol. 77, No. 10, at p. 621);

The Court of Appeals for the Fourth Circuit so held in *Peoples Bank v. International Finance Corp.*, 30 F. (2d) 46;

The Court of Appeals for the Sixth Circuit so held in *Humphreys v. First National Bank*, 75 Fed. 852;

*Cleveland etc. Coal Co. v. Main Island Creek Coal Co.*, 207 Fed. 60; and *Agler v. Cleveland etc. R. Co.*, 16 Fed. (2d) 455.

The Court of Appeals for the Eighth Circuit has so held in a number of cases, including *U. S. Fidelity, etc. Co. v. Board of Commissioners*, 145 Fed. 144; *Wear v. Imperial Windpie Glass Co.*, 224 Fed. 60; *United States v. Atchison, etc. R. Co.*, 270 Fed. 1; *Allen v. Cartan & Jeffrey Co.*, 7 F. (2d) 21; *First National Bank v. Littrer*, 10 F. (2d) 447; and *Gerlach v. Chicago, R. I. etc. R. Co.*, decided June 26, 1933, and reported in 18 U. S. Patents Quarterly Advance Sheets at p. 90. The case is as yet unreported in the Federal Advance Sheets.* The case last mentioned—*Gerlach v. Chicago, R. I. etc. R. Co.*—was an action at law brought to recover damages for the alleged infringement of patents, and was tried by the Court without a jury. At the close of all the evidence, the Court made findings of fact and conclusions of law in favor of the defendant, and based thereon entered judgment dismissing the action upon its merits. On the appeal from the judgment, the appellant sought to have the Court of Appeals pass upon the question of the sufficiency of the evidence. This the Court of Appeals refused to do, pointing out that by reason of the provisions of Sections 649 and 700 of the Revised Statutes it could not consider that question in the absence of any action by the plaintiff bringing that question before the trial Court.

The Court of Appeals for the Ninth Circuit has held that the question of law whether or not there was any substantial evidence to support findings of a trial Court in cases tried without a jury is reviewable only when that specific question has been presented to the trial Court and its ruling secured thereon during the trial, in the following cases: *Gillespie v. Hongkong & Shanghai Banking Corp.*, 23 F. (2d) 670; *Macomber v. Goldthwaite*, 22 F. (2d) 638; and *Phoenix Securities Co. v. Dittmar*, 224 Fed. 60.

The Supreme Court has so held in each of the following

* A copy of this opinion was forwarded to the Judges of this Court by counsel for appellees on July 25, 1933.

cases: *Fleischmann Co. v. United States*, 270 U. S. 349; *Martinton v. Fairbanks*, 112 U. S. 670. In *Martinton v. Fairbanks*, the Court said (p. 672):

> "If the question was whether all the evidence was sufficient in law to warrant a finding for the plaintiff, he should have presented that question, by a request for a definite ruling on that point."

**5. If this Court holds that power to review the findings of the trial Court results from the provisions of Section 269 of the Judicial Code (28 U. S. Code, Sec. 391), its decision is in direct conflict with the decision of the Court of Appeals for the Eighth Circuit in Allen v. Cartan & Jeffrey Co., 7 F. (2d) 21.**

As we have already pointed out, there is nothing in the opinion to indicate the basis of this Court's decision that it has power to review the findings of the trial Court notwithstanding Sections 649 and 700 of the Revised Statutes. But the fact that appellant's counsel advanced the proposition that such power results from Section 269 of the Judicial Code providing that appellate courts

> "shall give judgment after an examination of the entire record before the court, without regard to technical errors, defects, or exceptions which do not affect the substantial rights of the parties."

suggests that this Court may have adopted that view.

If this is the holding of the Court, its decision is in direct conflict with the decision of the Court of Appeals for the Eighth Circuit in *Allen v. Cartan & Jeffrey Co.*, 7 Fed. (2d) 21.

In that case the Court of Appeals for the Eighth Circuit had before it on appeal a case tried without a jury. The decision of the Court was that the question of law whether or not there was any substantial evidence to sustain the findings of the trial Court could not, under Sections 649

and 700 of the Revised Statutes, be reviewed because it had not been raised below, and that this was so regardless of the provisions of Section 269 of the Judicial Code.

Attention is also directed to the case of *Gillespie* v. *Hongkong & Shanghai Banking Corp.*, 23 F. (2d) 670, decided by the Court of Appeals for the Ninth Circuit. This was also a case tried without a jury and resulted in a holding that the necessity for raising questions for review by appropriate action in the trial Court has not been abolished by Section 269 of the Judicial Code.

**6. This Court has failed to understand appellees' contention that Gray's acquiescence in the rejection of claim 17, during the prosecution of his application, precludes a construction of the word "means" in claims 1 and 2 of his patent which would make them identical with the rejected claim; or, if it has understood the contention, has failed to state adequately the grounds upon which it holds the contrary.**

Claims 1 and 2 of Gray's patent describe the inner thrust member element of his combination as follows:

> "means intervening said stem and slide member for the transmission of endwise motion from said stem to said slide member."

It will be noted that the element is not restricted to any particular form, it might be a coiled wire tube or a straight wire so long as it connects the two slidable parts and serves to transmit endwise motion from the stem to the slide member.

As stated by the trial Court, the combination described, "if read as stated, * * * was clearly anticipated by the British patents," which show the identical combination using, however, a straight wire and not a coiled wire tube. If anticipation is to be avoided, the claims must be con-

strued to read "a coiled wire tube" instead of the unqualified word "means."

Appellant contended that the only means for transmitting endwise motion shown in the specification, is a coiled wire tube clearly described and illustrated in the patent drawing, and that the phrases "in a mechanism of the nature described," and "substantially as described," used in claims 1 and 2, qualify the word "means" and permit or require the claims to be construed as calling for "a coiled wire tube."

Appellees contended that Gray, during the prosecution of his application, presented a claim identical with claims 1 and 2, except for the fact that it called for "a coiled wire tube" instead of "means"; that the claim so presented was rejected by the Patent Office;* and that the Patent Office having rejected it, and Gray having acquiesced in such rejection, he cannot now have the benefit of his rejected claim, or such a construction of the claims that were allowed as would be equivalent thereto.

The trial Court found that Gray had made the claim which this Court now finds corresponded with the specification and drawings, and was Gray's real invention; that the patent office rejected that claim; that Gray acquiesced in such rejection; and that under the decision of the Supreme Court in *U. S. Repair, etc. Co.* v. *Assyrian Asphalt Co.*, 183 U. S. 591, Gray, having abandoned the claim for "a coiled wire tube," may not now claim the benefit of his rejected claim or such a construction of his present claim as would be equivalent thereto.

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* The claim was twice rejected by the Patent Office. In the rejection of February 25, 1918, the Examiner said (File Wrapper, pp. 19, 20):

> "To construct the transmission element of a coiled wire tube is not patentable in view of German to Wermann * * *."

Later, rejecting the claim again, the Examiner said (File Wrapper, p. 26):

> "The use of the 'coiled wire tube' for the 'intervening means' defined in claim 1 is not patentable in view of the German patent of record."

Speaking of the *Assyrian Asphalt Case,* the trial Court said:

> "The case is so nearly on all fours with U. S. Repair etc. Company *v.* Assyrian Asphalt, 183 U. S. 591, that the opinion in that case may be applied to this with a very little paraphrasing, * * *"

This court apparently did not understand the contentions made by appellees. We are led to this conclusion by the statement in the opinion (p. 19) that "we find nothing in the proceedings in the patent office to affect the *validity* of Gray's claims." The contention made by appellees is not whether the patent office proceedings affected the validity of the claims allowed, but whether the restriction to a "coiled wire tube" which appeared in cancelled claim 17 can be read into them. The statement in the opinion (p. 19) to the effect that no modification of the claims was required; leads to the same conclusion. In addition, the failure to mention whether, in the opinion of the Court, Gray did present a claim identical with claims 1 and 2 except that it called for a "coiled wire tube" instead of "means," is inexplicable except on the hypothesis that appellees' contentions were not understood. The same is true of the omission to state whether the patent office rejected the claim and whether Gray acquiesced therein. These questions are not answered by the statement in the opinion that Gray's original application "had an undue number of claims and duplications in many cases, and these were cut down." There is no discussion of whether these facts, if true, would stand in the way of such a construction of claims 1 and 2 as would be equivalent to the rejected claim. There is no discussion of the decision of the Supreme Court in the *Assyrian Asphalt Case,* particularly relied upon by appellees and by the Court below, nor is there any discussion of the case of *Morgan Envelope Co.* v. *Albany Paper Co.,* 152 U. S. 425, discussed in detail in our brief at pp. 18-21, and brought forward as dispositive of this case.

**7. This Court failed to distinguish between invention and the attainment of an improved result in holding that Christie's testimony answered the contention that Gray's device was a mere aggregation of old elements.**

This Court, in arriving at the conclusion that it required invention to conceive the idea of a closed coil inner thrust member and an open coil outer sheath member, gave great weight to the testimony of defendant's witness, Christie, that such a device had greater flexibility than one in which the inner thrust member was a straight wire, or one in which the outer member was a closed coil.

It is well settled that mere superiority does not make aggregation patentable. In practically every case in which the Supreme Court has held a device unpatentable as an aggregation, the superior utility of the device has been urged upon that Court without effect.

In *Grinnell Washing Machine Co.* v. *E. E. Johnson Co.*, 247 U. S. 426, 434, it was said:

> "Phillips may have produced a more convenient and economical mechanism than others who preceded him, but superiority does not make an aggregation patentable."

The reason why this is so was well expressed in *Bryant Electric Co.* v. *Reno Sales Co.*, 16 F. (2d) 789, 792, where it was said:

> "A skilled mechanic is all that is needed to assemble. There is no change in function, or in results, except possibly it may work more efficiently or safely, or less expensively, but that which has been 'discovered' has already been disclosed."

**8. The presumption of invention that ordinarily flows from the issuance of a patent cannot have application here for the reason that the Patent Office expressly held that the use of a coiled wire tube for the intervening means is not patentable.**

This Court, holding that Gray's real invention was the substitution of a coiled wire tube as the inner thrust member element of a cable release having an open coil outer sheath member, has decided that he is entitled to have claims 1 and 2 construed so as to read "a coiled wire tube" instead of the unqualified word "means."

In discussing the question of invention, the opinion (p. 12) makes the remarkable statement that this question "was decided in favor of the patentee" by the patent office, and says that "the trial Judge failed to give due weight to the presumption of invention arising from the grant of the patent."

The patent office, however, as we have heretofore pointed out, expressly held that the use of a coiled wire tube for the intervening means is not patentable and rejected claim 17 which claimed what is now said to be Gray's invention (See File Wrapper pp. 19-20, 26).

**9. It is not true, as stated at p. 10 of the opinion, that "the contention of lack of invention was evidently an afterthought, for at the first trial no such contention was made."**

The issue of lack of invention was directly raised in defendants' points for charge, numbered 19, 20, 22, 24, 25 and 27 (R. 187-190). The quoted statement of Judge Dickinson was taken as a denial of these requests and exceptions thereto were taken in accord with his statement at the end of the general charge that the points submitted were disaffirmed so far as not affirmed in the general charge (R. 173). The withdrawal of the issue of invention by the trial Court was vigorously urged by defendants-appellees as a reason why a new trial should be granted.

**It is not true, as stated at p. 10 of the opinion, that the trial Judge "made no Finding of Fact" on the question whether the conjoint use of a close wound inner coil and open wound exterior coil involved invention.**

It is the opinion that the trial Court confined ... expression of opinion" on this point ... to the remarks of the trial Judge ... quotation at the bottom of page 10 and at the top of ... Court's opinion the same certainly cannot ... carefully stated conclusion (R. 205) that

> ... commission of closed coil inner thrust member ... sheath member is not patentable ... were known to the prior art and ... operation or functional relationship ... them together.

... do not think they could have in ... upon in this case we want to ... assertions of fact that appear in ...

... statement on page 6 of the opinion and ... elsewhere in the opinion that "up to ... complex like Eastman continued ... with the pneumatic push." The ... in early 1913 Eastman Com- ... having a wire push member ... (Christie Q. 5, R. 141).

... statements on pages 9 and 15 of the opinion ... closed making other types" after ... and examined. The undisputed ... the manufacture of other types continues ...

... at the bottom of page 15 of the opinion ... evidently could not understand ... was affected" ignores com-

pletely the testimony discussed at pp. 30-38 of our brief showing that Eastman Company was fully aware of the advantages and had completely planned the production of a release embodying both a coiled wire thrust member and a spaced coil outer casing and had made a drawing showing them in combination before it ever heard of Gray or of his cable release.

Respectfully submitted,

PENNIE, DAVIS, MARVIS & EDMONDS,
BALLARD, SPAHR, ANDREWS & INGERSOLL,
*Attorneys for Appellee.*

WILLIAM H. DAVIS,
GEORGE E. MIDDLETON,
CHAS. W. RILEY,
BOYD LEE SPAHR,
ALLEN HUNTER WHITE,
*Of Counsel.*

CERTIFICATE

I certify that this petition for rehearing, in my opinion, is well founded in law and in fact, and that it is not filed for the purposes of delay.

ALLEN HUNTER WHITE
*Attorney for Petitioner*

IN THE UNITED STATES CIRCUIT COURT OF APPEALS FOR THE THIRD CIRCUIT, OCT. TERM, 1932

No. 4986

CHARLES B. GRAY, Appellant,

v.

EASTMAN KODAK COMPANY et al., Appellees

Sur Petition for Rehearing

And now, to wit: October 31, 1933, after due consideration, the petition for rehearing in the above entitled case is hereby denied.

Philadelphia, October 31, 1933.

Per Curiam:

Buffington, Circuit Judge.

Endorsements: 4986. Order Denying Petitions for Rehearing. Rec'd & Filed Oct. 31, 1933. Wm. P. Rowland, Clerk.

UNITED STATES OF AMERICA,
Eastern District of Pennsylvania,
Third Judicial Circuit, set:

I, Wm. P. Rowland, Clerk of the United States Circuit Court of Appeals for the Third Circuit, do hereby certify the foregoing to be a true and faithful copy of the original Transcript of Record and proceedings in this Court in the case of Charles B. Gray, Appellant, vs. Eastman Kodak Co. et al., Appellees, No. 4986, on file, and now remaining among the records of the said Court, in my office.

In testimony whereof, I have hereunto subscribed my name and affixed the seal of the said Court, at Philadelphia, this 4th day of November, in the year of our Lord one thousand nine hundred and thirty-three and of the Independence of the United States the one hundred and fifty eighth.

Wm. P. Rowland, Clerk of the U. S. Circuit Court of Appeals, Third Circuit. (Seal United States Circuit Court of Appeals, Third Circuit.)

[fols. 245 & 245a] SUPREME COURT OF THE UNITED STATES

STIPULATION AS TO EXHIBITS—Filed Jan. 8, 1934

And now, to wit, this second day of December, 1933, come Thomas Raeburn White, Esq., counsel for respondent, and Allen Hunter White, Esq., counsel for petitioners, who stipulate and agree that none of the exhibits in the above entitled cause need be printed by the Clerk of the Supreme Court of the United States in connection with the docketing of the petition for writ of certiorari in the said cause and the consideration thereof by the Court; and that if the said writ of certiorari be granted by the Court, all of said exhibits, except the physical exhibits, shall be printed or photolithographed in the usual manner.

T. R. White, Allen Hunter White.

[fol. 245b] [File endorsement omitted.]

[fols. 246 & 246a] SUPREME COURT OF THE UNITED STATES

ORDER ALLOWING CERTIORARI—Filed February 5, 1934

The petition herein for a writ of certiorari to the United States Circuit Court of Appeals for the Third Circuit is granted. And it is further ordered that the duly certified copy of the transcript of the proceedings below which accompanied the petition shall be treated as though filed in response to such writ.